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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,069	04/05/2001	Dustin M. Davis	027448.0006	7258
22202	7590	12/20/2004	EXAMINER	
WHYTE HIRSCHBOECK DUDEK S C 555 EAST WELLS STREET SUITE 1900 MILWAUKEE, WI 53202			NORRIS, TREMAYNE M	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,069

Applicant(s)

DAVIS ET AL.

Examiner

Tremayne M. Norris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-280 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Elections/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, 53-103, 141-155, 193-243 drawn to a combination for enrolling a user into a biometric verification system and using the system for authenticating the user, classified in class 713, subclass 201.
- II. Claims 16-52, 104-140, 156-192, and 244-280, drawn to a subcombination for authenticating a user, classified in class 713, subclass 201.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the invention of group I does not include the limitations of receiving unrestricted authentication data from the applicant, retrieving *all* master templates associated with said identification data, and accessing the system if a live template corresponds to one of the master templates according to predefined criteria. In other words, the combination does not require the particular retrieval scheme for master templates specified in the subcombination, where all master

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templates for a particular identification data value are retrieved regardless of whether the master templates are all for a particular user. The subcombination has separate utility because it can be used in a system where using a different user enrollment scheme.

Examination of the invention of Group II would require searching class 707, subclass 3 - query processing (i.e., searching) - while the invention of Group I would not. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

If the applicant elects Group I, this application contains claims directed to the following patentably distinct species of the claimed invention of Group I:

(A1) where the biometric sample is a fingerprint – per claims 5, 56, 78, 93, 145, 196, 218, 233;

(B1) where the biometric sample is a voiceprint – per claims 6, 57, 79, 94, 146, 197, 219, 234;

(C1). where the biometric sample is a handprint – per claims 7, 58, 80, 95, 147, 198, 220, 235;

(D1) where the biometric sample comprises handwriting – per claims 7, 59, 81, 96, 148, 199, 221, 236;

(E1) where the biometric sample comprises hand geometry – per claims 8, 60, 82, 97, 149, 200, 222, 237;

(F1) where the biometric sample comprises facial geometry – per claims 9, 61, 83, 98, 150, 201, 223, 238;

(G1) where the biometric sample comprises facial recognition – per claims 10, 62, 84, 99, 151, 202, 224, 239;

(H1) where the biometric sample comprises a retinal scan – per claims 11, 63, 85, 100, 152, 203, 225, 240;

(I1) where the biometric sample comprises an iris scan – per claims 12, 64, 86, 101, 153, 204, 226, 241;

(J1) where the biometric sample comprises thermal imaging – per claims 13, 65, 87, 102, 154, 205, 227, 242.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4, 15, 53-55, 66-77, 88-92, 103, 141-144, 155, 193-195, 206-217, 228-232, and 243 are generic to the invention of Group I.

If the applicant elects Group II, this application contains claims directed to the following patentably distinct species of the claimed invention of Group I:

(A2) where the biometric sample is a fingerprint – per claims 43, 131, 183, 271;

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(B2) where the biometric sample is a voiceprint – per claims 44, 132, 184, 272;

(C2) where the biometric sample is a handprint – per claims 45, 133, 185, 273;

(D2) where the biometric sample comprises handwriting – per claims 46, 134, 186, 274;

(E2) where the biometric sample comprises hand geometry – per claims 47, 135, 187, 275;

(F2) where the biometric sample comprises facial geometry – per claims 48, 136, 188, 276;

(G2) where the biometric sample comprises facial recognition – per claims 49, 137, 189, 277;

(H2) where the biometric sample comprises a retinal scan – per claims 50, 138, 190, 278;

(I2) where the biometric sample comprises an iris scan – per claims 51, 139, 191, 279;

(J2) where the biometric sample comprises thermal imaging – per claims 52, 140, 192, 280.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is

finally held to be allowable. Currently, claims 16-42, 104-130, 156-182, and 244-270 are generic to the invention of Group II.

Applicant is advised that a reply to this requirement must include an identification of the species for the particular invention that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined and the corresponding species even though the requirement be traversed (37 CFR 1.143).

Conclusion

A shortened statutory period for response to this action is set to expire **one month** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tremayne M. Norris whose telephone number is (571) 272-3874. The examiner can normally be reached on M-F 7:30AM-5:00PM alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tremayne Norris

December 9, 2004



Andrew Caldwell
Andrew Caldwell